

REMARKS

The present application was filed on December 4, 2003 with claims 1-26. Claims 9-26 have been cancelled, so claims 1-8 remain pending in the application. Applicant reserves the right to pursue the cancelled claims in a divisional application.

In the Office Action of January 2, 2008, the Examiner has maintained the rejection of claims 1 and 3-8 on the grounds of nonstatutory obviousness-type double patenting as unpatentable over claims 1-12 of U.S. Patent No. 6,878,757 to Roby (hereinafter Roby '757"). Applicant will file a suitable terminal disclaimer upon indication that the claims are otherwise allowable in this application.

The Examiner has maintained the rejection of claims 1-8 under 35 U.S.C. §103 (a) as obvious over U.S. Patent No. 5,716,376 to Roby (hereinafter "Roby '376") in view of U.S. Patent No. 4,201,216 to Mattei ("Mattei"). However, nowhere does Roby '376 disclose or suggest a coating for a surgical article including a copolymer having a predominant amount of epsilon-caprolactone and a minor amount of at least one other bioabsorbable copolymerizable monomer, and an effective antimicrobial amount of a metal salt of a fatty acid selected from the group consisting of fatty acid salts of lithium, rubidium, cesium, francium, beryllium, magnesium, strontium, barium, radium, aluminum, tin, lead, bismuth, transition metal, and mixtures thereof as recited in claim 1.

Mattei fails to remedy the deficiencies of Roby '376. Nowhere does Mattei disclose or suggest a coating for a surgical article including a copolymer having a predominant amount of epsilon-caprolactone and a minor amount of at least one other bioabsorbable copolymerizable monomer, and an effective antimicrobial amount of a metal salt of a fatty acid selected from the

group consisting of fatty acid salts of lithium, rubidium, cesium, francium, beryllium, magnesium, strontium, barium, radium, aluminum, tin, lead, bismuth, transition metal and mixtures thereof as recited in claim 1. Mattei's copolymer is preferably lactide and glycolide; nowhere in Mattei is there any mention or suggestion of epsilon-caprolactone. Moreover, as acknowledged by the Examiner, Mattei prefers calcium stearate; calcium salts are not recited in claim 1.

As previously noted, the Examiner incorrectly interprets applicants' specification to suggest that it states metal salts of higher fatty acids were known in the art to be useful in preparing coatings or suture materials. To repeat, the applicants' specification notes as follows:

Although calcium stearate was used as a component in the Vicryl® suture coating, the manufacture and application of such a suture coating utilizes an impractical and uneconomical dip coating process because calcium stearate (a hydrophobic metal salt of a fatty acid) generally is water insoluble. Therefore, a suture coating fabricated from materials that would dissolve in solution and thus obviate the necessity of using dip coating processes would provide manufacturing advantages.

As is clear from the above, the language cited by the Examiner regarding the use of calcium stearate in a coating notes that it would require an *impractical and uneconomical* dip coating process, as the salt is generally insoluble. Thus, contrary to the Examiner's assertions, the specification herein notes deficiencies in the use of calcium stearate, which does not suggest and, in fact and to the contrary, teaches away from the use of the claimed salts in formulating applicant's coatings. As the recited polymer and salts both differ from the polymer and salts

recited by Mattei, and applicant has described deficiencies with the salts utilized by Mattei, Mattei fails to render the pending claims obvious.

As neither of the cited references provide all of the recited limitations, the Examiner has failed to establish a prima facie case of obviousness. To combine the references as suggested by the Examiner requires impermissible hindsight, i.e., applicant's own disclosure, to provide the impetus to combine the references, especially in view of the fact that Mattei's salts require the use of an impractical and uneconomical dip coating process. Thus, there is no motivation or suggestion to combine the references as suggested by the Examiner, nor would one skilled in the art have any reasonable expectation of success in combining the references as suggested by the Examiner.

Thus, it is respectfully submitted that neither Roby '376 nor Mattei, taken alone or in any combination, render claim 1 obvious, nor claims 2-8 which depend, directly or indirectly, therefrom.

Therefore, for at least the foregoing reasons, neither Roby '376 nor Mattei render obvious claims 1-8 of the instant application and reconsideration of this rejection is respectfully requested.

It is believed that the claims of the application, i.e., claims 1-8, are patentably distinct over the art of record and are in condition for allowance. In the event that the Examiner believes that a telephone conference or a personal interview may facilitate resolution of any remaining

matters, the undersigned may be contacted at the number indicated below. Entry of the foregoing amendment and remarks, and early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



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